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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,868	03/16/2004	Qun-Sheng Ji	OS-10002	8803

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EXAMINER

LOCKARD, JON MCCLELLAND

ART UNIT PAPER NUMBER

1647

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/801,868	Applicant(s) JI, QUN-SHENG	
	Examiner Jon M. Lockard	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, 15-20, 23, and 26-35, drawn to hybrid receptor protein-kinase fusion proteins, nucleic acids encoding the same, vectors and host cells comprising said nucleic acids, and a method of recombinantly producing the fusion proteins, classified in class 435, subclasses 69.7, 252.3, and 320.1, class 530, subclass 387.3, and class 536, subclass 23.4, for example.
  - II. Claims 13-14, 21-22, 24-25, drawn to a method for screening compounds which modulate a hybrid receptor protein-kinase fusion protein, classified in class 435, subclass 7.1, class 436, subclasses 501 and 519, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the fusion proteins of Invention I can be used in the in assay methods of Invention II, but the fusion proteins can also be used to produce antibodies, which is a materially different method.

### *Election of Species:*

In addition to the above Restriction requirement, a further election of species is required as follows:

3. This application contains claims directed to the following patentably distinct species of the claimed invention: Whatever Invention is elected, two separate species requirements are set forth. Applicants must **(a)** select one of the following species of the heterologous receptor protein-tyrosine kinases set forth in claim 2. The species are independent or distinct because each of the kinase domains from the different receptor protein-tyrosine kinases represents a physically and functionally distinct chemical entity, having different structures and activities, and each would require separate non-overlapping searches. Furthermore, searching more than one of the 114 different inventions would impose a serious search burden since a search of one of the receptor protein-tyrosine kinases would not be used to determine the patentability of any of the other receptor protein-tyrosine kinases, and vice-versa. Accordingly, the methods of using the compounds are also, therefore, patentably distinct.

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claims 1, 12, 13, 15, 21, 23, 24, and 26 are generic.

5. Additionally, Applicants must also **(b)** select a single molecular embodiment of a modified extracellular domain of the Ret receptor. The species are independent or distinct because each of the modified extracellular domain of the Ret receptor represents a physically and functionally distinct chemical entity, having different structures and activities, and each would require separate non-overlapping searches. Furthermore, searching more than one of the infinitely large number of the different inventions would impose a serious search burden since a

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search of one of the modified extracellular domains of the Ret receptor would not be used to determine the patentability of any of the other modified extracellular domains of the Ret receptor, and vice-versa. Accordingly, the methods of using the compounds are also, therefore, patentably distinct.

6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claims 1, 12, 13, 15, 21, 23, 24, and 26 are generic.

7. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with each of the two species election requirements, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). To be fully responsive, Applicants must comply with the following:

Whatever Invention is elected, Applicants must select one species from each of the two (2) types listed, **(a)** a heterologous receptor protein-tyrosine kinases, and **(b)** a modified extracellular domain of the Ret receptor.

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10. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for each group is not required for the other groups because each group requires a different non-patent literature searches, restriction for examination purposes as indicated is proper.

11. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

12. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

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patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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*Advisory Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jon M. Lockard, Ph.D.** whose telephone number is **(571) 272-2717**. The examiner can normally be reached on Monday through Friday, 8:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Brenda Brumback**, can be reached on **(571) 272-0961**.

The fax number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Jon M. Lockard, Ph.D.  
September 27, 2006

CHRISTINE J. SAUD  
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Christine J. Saud". The signature is written in dark ink and is positioned below the printed name and title of the examiner.